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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,835	07/13/2005	Ugo Piero Bianchi	264475US0X PCT	7218
22850 7590 07/17/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SHAMEEM, GOLAM M	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 07/17/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

Application No.

10/519,835

Applicant(s)

BIANCHI ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-55 is/are pending in the application.
- 4a) Of the above claim(s) 29-40 (in-part) and 41-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 01/11/2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

This application is a 371 of PCT/EP03/07303 07/08/2003 and the claim of foreign priority under 35 U.S.C. § 119(a)-(d) to Italy M12002 A 001537 07/12/2002 is acknowledged.

### ***Status of Claims***

Claims 29-55 are currently pending in the application. Claims 1-28 were canceled.

Receipt is acknowledged of amendment / response filed on May 01, 2007 and that has been entered.

Claims 29-40 (in-part) and 41-55 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

### ***Information Disclosure Statement***

Receipt is acknowledged of Information Disclosure Statement (IDS), filed on 01/11/2005, which has been entered in the file.

### ***Response to Election/Restriction***

In response to the restriction requirements, Applicants have elected Group V, which includes claims 29-40 drawn to a compound of formula (I), with traverse is acknowledged. Applicant's arguments (to withdraw restriction among Groups I-XVIII) have been fully considered and found unpersuasive at this time because the Invention groups I-XVIII differ materially in structure and in element from each other and therefore, are capable of supporting their own patents.

The invention Groups I-XVIII each relate to a set of structurally diverse and dissimilar compounds [having different variable groups, which are attached directly and indirectly to the

Art Unit: 1626

formula II], process of preparing compounds, and their compositions, which do not possess a substantial common core wherein a reference anticipating one would not necessarily render the other obvious. The core does not define a contribution over the art. The ring structure of formula (I) is further substituted by different variables such A, R1, R2 and X etc, which are broadly defined and when the compound of formula (I) is taken as a whole, a plethora of vastly different compounds are possible. Thus these features are not considered 'special technical features' under PCT rules 13.1 and 13.2. Hence, the unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

In addition, 35 U.S.C. 372 (b)(2) clearly states that unity of invention may be reexamined under 35 U.S.C. 121. Restriction was based on PCT Rule 13.1, 13.2 and Annex B part 1(b) together with 37 CFR 1.475 and 1.499 for lacking unity of invention because of lacking a significant structural element qualifying as the special technical features.

PCT Rule 13.2 states that the international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (requirement of unity of invention).

PCT Rule 13.2 states that unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

Annex B (2)(V) when dealing with alternatives, if it can be shown that at least one Markush alternative is not novel over the prior art, the question of unity of invention shall be reconsidered by the Examiner. Reconsideration does not necessarily imply that an objection of lack of unity shall be raised. If the Examiner finds one of the inventions unpatentable over the

prior art the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention. Nevertheless, Examiner may reconsider to rejoin one process of making claim and / or one method of use claim commensurate in scope with the product claims when the case would be found in condition for allowance [provided those process or method of use claims are free from 35 U.S.C. §112 first (including written description, reach-through claim language and/or scope-enablement issues) and second paragraphs]. For these reasons, Applicant's arguments are found unpersuasive and, since 35 U.S.C. 101 allows one patent per invention, the requirement for restriction (election of species) is still deemed sound and proper.

Applicants preserve their right to file a divisional on the non-elected subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 29-40 are rejected under 35 U.S.C. § 102(b) as being anticipated by Venturello *et al* (US 5,536,434). Applicant claims substituted imidoalkanpercarboxylic acids, compositions and their process of preparation thereof. Venturello *et al* also disclose several imido-alkanpercarboxylic acids derivatives at least one of which anticipates the instantly claimed invention wherein A is cyclohexyl, X is hydrocarbon chain and M is hydrogen [see column 10, claim 2, formula (II)], which reads on the instantly claimed compounds.

Suzuki *et al* (1993) also disclose several imido-alkanpercarboxylic acids derivatives at least one of which anticipates the instantly claimed invention wherein A is Aryl (phenyl), X is

Art Unit: 1626

hydrocarbon chain and M is hydrogen [STN International, HCAPLUS database, RN 128275-31-0, a copy is provided with this Office action], which reads on the instantly claimed compounds.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29-40 are rejected under the judicially created doctrine of obviousness-type double patenting, as being unpatentable over claims 1-9 of co-pending Application No. 10/585,659 and / or also over claims 21-32 of co-pending Application No. 10/592,538. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to the same art recognized subject matter. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented. The compounds and compositions taught by co-pending applications are similar to instant application because a reference anticipating one set of claim will render the other obvious and it would have been obvious to one of ordinary skill in the art at the time of the invention was made since Bianchi *et al* teach the generic compounds and compositions which are similar to the instantly claimed invention.

The subject matter claimed in the instant application is fully disclosed and covered in the above referenced co-pending applications. Therefore, the disclosure of Bianchi *et al* that teach

Art Unit: 1626

many permutation and combination substitutions [having various Markush variable substitutions, such as A, R1, R2 and X etc in core compound (including composition or formulation)], which would easily place Applicants invention in possession of the public at the time of Applicants invention was filed. The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). Therefore, in the instant case, one skilled in the chemical art would be motivated to choose to replace various Markush variables in core formula (I) to obtain the desired products in view of the known teaching of the art. The claimed compounds / compositions are so closely related structurally to the homologous and /or analogous compounds / compositions of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. Moreover, any other differences are but obvious structural modifications, which would be apparent to one skilled in the chemical art that can use similar substitutions, would expect to have the same or essentially the same results. Therefore, in looking at the instant claimed compounds as a whole, the claimed compounds would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

#### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golem Shamed, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Tuesday-Friday from 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number

Art Unit: 1626


for this Group is (703) 308-7921. The Official fax phone number for this Group is 571-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mcKane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M. M. Shameem, Ph.D.  
Primary Examiner  
Art Unit 1626,  
Technology Center 1600



**GOLAM M. M. SHAMEEM, PH.D.**  
**PRIMARY EXAMINER**

June 26, 2007